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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,018	07/09/2003	Roland Albert	071308.0446	1121
31625	7590	07/21/2004		
BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039			EXAMINER KIM, CHONG HWA	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/616,018

Applicant(s)

ALBERT ET AL.

Examiner

Chong H. Kim

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-22 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/9/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hydraulic gearbox control device in a motor vehicle as recited in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 3, 7-14, 16, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "such" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 2, 3, 7, 8, 10, 11, 16, 18, and 19, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 4, 7, 8, 11, 12, 15, 16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Spiess et al., DE 197 15 592 A1.

Spiess et al. shows, in Figs. 1 and 2, a plastic plate of a hydraulic gearbox control device in a motor vehicle, comprising;

at least one channel 5 which runs through the plastic control plate and is used for carrying a cooling medium;

a heat conduction body 8 which is at least partly integrated in the plastic control plate and is arranged directly adjacent to the channel;

wherein the heat conduction body is designed in such a way that the cooling medium flows against it;

wherein a flat area of the heat conduction body is designed as a wall area of the channel;

wherein the gearbox control electronics system is arranged directly on the upper surface of the heat conduction body; and

wherein the gearbox control electronics system is electrically contacted via an electrical circuit board.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spiess et al. in view of Farshi et al., U.S. Patent 6,396,692 B1.

Spiess et al. shows, as discussed above in the rejections of claims 1, 7, and 15, the gearbox control electronics system having the heat conduction body, but fails to show the body being a metal plate.

Farshi teaches, in column 5, line 17-23, a heat conduction body 36 can be made with aluminum.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the heat conducting material of Spiess with the aluminum heat conduction body as taught by Farshi in order to provide a more effective heat sink material so that the electronic system is prevented from being overheated.

8. Claims 1, 2, 5-8, 10, 13-16, 18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loibl et al., U.S. Patent 6,160,708 in view of Farshi et al., U.S. Patent 6,396,692 B1.

Loibl et al. shows, in Figs. 1-4, a plastic plate 11 of a hydraulic gearbox control device in a motor vehicle, comprising;

a heat conduction body 8 which is at least partly integrated in the plastic control plate;  
wherein the heat conduction body is designed in such a way that the cooling medium flows against it;

wherein the gearbox control electronics system 23 is arranged directly on the upper surface of the heat conduction body;

wherein the gearbox control electronics system is electrically contacted via an electrical circuit board;

wherein the upper surface of the plastic control plate is flush with the upper surface of the heat conduction body;

but fails show at least one channel which runs through the plastic control plate and is used for carrying a cooling medium;

Farshi shows, in Fig. 3, a heat conduction body 36 that is designed in the form of a U (the U-shaped halves) wherein the inner sides of the U form wall areas of the channel 32 which runs through the plastic control plate and is used for carrying a cooling medium.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the heat sink of Loibl et al with the cooling medium carrying channel form in the control plate with the conduction body as taught by Farshi et al. in order to provide a more effective heat dissipating system so that the electronic system is prevented from being overheated.

#### *Allowable Subject Matter*

9. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Electronic control system on engine or gearbox.

Klecker et al., U.S. Patent 5,361,650

Ulm, U.S. Patent 5,709,134

Taniguchi et al., U.S. Patent 5,823,070

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Starker et al., U.S. Patent 5,662,007

Braun et al., U.S. Patent 5,845,545

Bek, U.S. Patent 6,679,137 B1

Barge, U.S. Patent 4,378,760

Demens AG, DE Pub No. 29513950 U1

Electronic control system with cooling device.

Collins et al., U.S. Patent 5,276,584

Mankaruse et al., U.S. Patent 6,411,512 B1

Mizzi, U.S. Patent 5,245,508

Sakakibara et al., U.S. Patent 4,559,864

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Tuesday - Friday; 8:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

chk  
July 16, 2004

  
CHONG H. KIM  
PRIMARY EXAMINER